

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

Baker et al.

Docket No:

39780-2830P1C7

Serial No:

10/006,130

Group Art Unit:

1647

Filed:

December 6, 2001

Examiner:

Rachel B. Kapust

For:

SECRETED AND TRANSMEMBRANE POLYPEPTIDES AND NUCLEIC

ACIDS ENCODING THE SAME

Commissioner for Patents Washington, D.C. 20231

DECLARATION OF AUDREY GODDARD, Ph.D. UNDER 37 CFR 1.131

- I, Audrey Goddard, Ph.D. do hereby declare and say as follows:
- I am Senior Clinical Scientist at the Diagnostics, Development Sciences Department 1. of Genentech, Inc., South San Francisco, CA 94080.
- I am one of the inventors of the above-identified application. 2.
- I have read and understood the claims pending in this application, and are aware that 3. the claims have been rejected as anticipated by U.S. Patent Publication No. 2003/0096951 (Jacobs et al., publication date May 22, 2003 and effective filing date August 14, 1998).
- I, along with other inventors of this application, conceived and reduced to practice the 4. polypeptide designated as PRO1244 (SEQ ID NO:130) claimed in the above-identified application in the United States prior to August 14, 1998.
- At the time the PRO1244 polypeptide was cloned and sequenced I was responsible for 5. overseeing the sequencing of novel polypeptides, including the PRO1244 polypeptide (SEQ ID NO:130) claimed in the above-identified application.
- A cDNA clone, referred to as DNA64883-1526 in the above-identified application, 6. was identified as encoding the PRO1244 polypeptide.
- 7. The full length of the cDNA clone is shown in Figure 73 of the above-identified application. The full-length cDNA sequence has 2213 nucleotide residues. The full length of the PRO1244 peptide encoded by DNA64883-1526 is shown in Figure 74 of

- the above-identified application. The full-length PRO1244 polypeptide has 335 amino acid residues.
- 8. Copies of the pages from the GSeqEdit database which report the cloning and sequencing data for the PRO1244 polypeptide sequence and its encoding nucleic acid sequence are attached to this declaration (with the dates redacted) as Exhibit A.
- 9. The GSeqEdit report shows the full-length nucleic acid sequence for DNA-64883-1526 (identified as "DNA-64883") and the full-length PRO1244 polypeptide encoded by DNA 64883. Both the DNA-64883 and the PRO1244 polypeptide sequences were obtained prior to August 14, 1998.
- The DNA-64883 sequence shown in the GSeqEdit report is identical to that of SEQID NO: 129 disclosed in the above-identified application.
- 11. The beginning of the cDNA sequence corresponding to SEQ ID NO: 129 in the above-identified application is shown on page 1 of the GSeqEdit database report and the location of the first nucleotide is marked with "^insert starts here" and an arrow. The location of the last nucleotide corresponding to SEQ ID NO: 129 is shown on page 11 and is marked with an arrow.
- 12. The amino acid sequence shown in the GSeqEdit report is identical to that of SEQ ID NO: 130 disclosed in the above-identified application.
- 13. The first 26 amino acid residues of the PRO1244 polypeptide (SEQ ID NO:130) encoded by the cDNA (DNA-64883) are also shown on page 1 of the GSeqEdit report and the remaining 309 residues appear on pages 2-6 of the report.
- 14. Exhibit A clearly shows that both the full-length DNA-64883 sequence and the full-length PRO1244 polypeptide sequence disclosed in the above-identified application were obtained prior to August 14, 1998.
- 15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information or belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001

of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

Audrey Goddard

Date

SV 2037583 v1 6/15/04 3:02 PM (39780.2830)



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SECRETED AND TRANSMEMBRANE POLYPEPTIDES AND NUCLEIC

ACIDS ENCODING THE SAME

Commissioner for Patents Washington, D.C. 20231

DECLARATION OF WILLIAM WOOD, Ph.D. UNDER 37 CFR 1.131

- I, William Wood, Ph.D. do hereby declare and say as follows:
- I am Director and Staff Scientist at the Department of Bioinformatics, of Genentech, 1. Inc., South San Francisco, CA 94080.
- 2. I am one of the inventors of the above-identified application.
- I have read and understood the claims pending in this application, and are aware that 3. the claims have been rejected as anticipated by U.S. Patent Publication No. 2003/0096951 (Jacobs et al., publication date May 22, 2003 and effective filing date August 14, 1998).
- 4. I, along with other inventors of this application, conceived and reduced to practice the polypeptide designated as PRO1244 (SEQ ID NO:130) claimed in the above-identified application in the United States prior to August 14, 1998.
- At the time the PRO1244 polypeptide was cloned and sequenced I was responsible for 5. overseeing the cloning of cDNAs which encoded novel polypeptides, including the cDNA that encoded PRO1244 polypeptide (SEQ ID NO:130) claimed in the aboveidentified application.
- A cDNA clone, referred to as DNA64883-1526 in the above-identified application, 6. was identified as encoding the PRO1244 polypeptide.
- The full length of the cDNA clone is shown in Figure 73 of the above-identified 7. application. The full-length cDNA sequence has 2213 nucleotide residues. The full

- length of the PRO1244 peptide encoded by DNA64883-1526 is shown in Figure 74 of the above-identified application. The full-length PRO1244 polypeptide has 335 amino acid residues.
- 8. Copies of the pages from the GSeqEdit database which report the cloning and sequencing data for the PRO1244 polypeptide sequence and its encoding nucleic acid sequence are attached to this declaration (with the dates redacted) as Exhibit A.
- 9. The GSeqEdit report shows the full-length nucleic acid sequence for DNA-64883-1526 (identified as "DNA-64883") and the full-length PRO1244 polypeptide encoded by DNA 64883. Both the DNA-64883 and the PRO1244 polypeptide sequences were obtained prior to August 14, 1998.
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- 13. The first 26 amino acid residues of the PRO1244 polypeptide (SEQ ID NO:130) encoded by the cDNA (DNA-64883) are also shown on page 1 of the GSeqEdit report and the remaining 309 residues appear on pages 2-6 of the report.
- 14. Exhibit A clearly shows that both the full-length DNA-64883 sequence and the full-length PRO1244 polypeptide sequence disclosed in the above-identified application were obtained prior to August 14, 1998.
- 15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information or belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and

the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

William Wood

Date

SV 2037583 v1 6/9/04 1:21 PM (39780.2830) Exhibit A to Declarations of Audrey Goddard and William Wood under 37 CFR 1.131

GSeqEdit Database Report

>human ortholog of implantation-associated protein - Rattus DNA64883 sheldens GSeqEdit DNA64883 goddarda GSeqEdit DNA64883 zemin GSeqEdit DNA64883 wiw GSeqEdit >510 Sites [All Sites] >DNA64883 [Full]

>HBN64883.seq, sequenced at ABI/ACGT by Peter Ma and Ellson Chen

maeII/hpyC hpy99I mnll 1 CGGAATICGG CICGAGGAGC GAACAIGGCA GCGCGTIGGC GGTTITGGIG IGTCICIGIG ACCAIGGIGG IGGCGCIGCI CAICGIIIGC GACGIICCCI GCCTTAAGCC GAGCTCCTCG CTTGTACCGT CGCGCAACCG CCAAAACCAC ACAGAGACAC TGGTACCACC ACCGCGACGA GTAGCAAACG CTGCAAGGGA taiI fnu4HI/bsoFI hhal/cfol tseI Ivqq hinPI haeII btgI/bstDSI nlaIII mslI bstXI bsaJI dsaI styl ncol tsp45I bsmAI maeIII tseI bstUI[M.hhaI-] hinPI acil fnuDII/mvnI bbvI bsh1236I nlaIII hhaI/cfoI fnu4HI/bsoFI MAARW thaI aval[M.taqI-] paeR71 mwoI tsp5091[M.ecoRI-] apol mwol bseRI mnll taqI xhoI tliI smll ecoRI

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GSeqEdit, DNA64883 [Full], page 2

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1301 ATTATAAAAA TIGTAAAACT ACTACTITGI TITAGTTAGA ACAAAGCTCA AAACTACTIT AGTTAACTIG GTCATCTGAI ITTATATTGC CTTATCCAAA taatattiti aacaititga igaigaaaca aaatcaaici igiticgagi ittgaigaaa icaatigaac cagtagacta aaatataacg gaataggiti bslI hincII/hindII hpy188I aluI

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taiI

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hpy188I maeII/hpyCH4IV hpy1881 mboll

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nlaIII bbsI

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bst1107I bst217I

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aflii maei bspC

eco57I

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tru9I maeIII hphI

tsp45I

hincII/hindII hpaI

tsp5091

msel

hinfI asp700 XmnI

hpy188I

ddeI

msel bstEII

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GACACTATIT TIAIATCGAA TCACGATITI AGTCACATIG AATATGTACC GGATTITACA AAGATGTTTA ATCTCAAACA GTGAATAAGG TAAACATGGA 1801 CIGIGATAAA AATATAGCIT AGIGCTAAAA TCAGIGIAAC TTATACAIGG CCTAAAAIGI ITCTACAAAI TAGAGITIGI CACTTATICC AITIGIACCI

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dpnII[d mboI/nd

dpnI[da

mnll bsaJI

bspCNI

1901 AAGAGAAAAA TAGGCTCAGI TAGAAAAGGA CICCCTGGCC AGGCGCAGTG ACTTACGCCT GTAATCICAG CACTITGGGA GGCCAAAGGCA GGCAGAICAC

hinf! apyl[dcm+] bts!

bspCNI

TICTCITITI AICCGAGICA AICITITCCI GAGGGACCGG ICCGCGICAC IGAAIGCGGA CAITAGAGIC GIGAAACCCI CCGGIICCGI CCGICTAGIG

2001 GAGGICAGGA GIICGAGACC AICCIGGCCA ACAIGGIGAA ACCCCGICTC TACTAAAAAT AIAAAAAITA GCIGGGIGIG GIGGCAGGAG CCIGIAAICC CICCAGICCI CAAGCICIGG IAGGACCGGI IGIACCACII IGGGGCAGAG AIGAITITIA IAITITIAAI CGACCCACAC CACCGICCIC GGACAITAGG aluI tsp509I bsmAI esp3I bsmBI hpy188III apy1[dcm+] hphI mscI/ball[dcm-] nlaIII hpy188III bsaI bstF5I haeIII/palI eael[dcm-] ecoRII[dcm-] bssKI[dcm-] scrFI[dcm-] dsaV[dcm-] taqI fokI cfrI bstNI pspGI mvaI bsmAI

GTCGATGIGT CCTCCGACTC CGTGCTCTTA GTGAACTTGA GTCCTCTACC TCCAAAGTCA CTCGGCTCTA GTGCGGTGAC GTGAGGTCGG ACCGTTGTCT 2101 CAGCTACACA GGAGGCTGAG GCACGAGAAT CACTTGAACT CAGGAGATGG AGGTTTCAGT GAGCCGAGAT CACGCCACTG CACTCCAGCC TGGCAACAGA ecoRII[dcm-] bssKI[dcm-] apyI[dcm+] dsaV[dcm-] dpnI[dam+] bsgI bpmI/gsuI[dcm-] bstNI dpnII[dam-] hpyCH4V mbol/ndeII[dam-] tspRI btsI sau3AI tspRI mnlI hpy188III **bspcNI** ddeI hinfI tfiI mnli mnli bssSI DSPCNI ddeI

aluI

scrFI[dcm-]

nlaIV

pspGI

mvaI

fnu4HI/bsoFI

haeIII/palI

mcrI

eagI/xmaIII/eclXI

eaeI

cfrI

bsiEI

rmaI

mael notI

fnu4HI/bsoFI bfaI

hinfI

bsmAI

plei mlyI

2201 GCGAGACTCC ATCTCAAAAA AAAAAAAA AAAAAAAA AAAAAAAGG CGGCCGCCGA CTAGTGAGC acil acil

CGCTCTGAGG TAGAGTTTTT TTTTTTTT TTTTTTT TTTTTTCC GCCGCCGCT GATCACTCG

> length: 2269

accI (GTMKAC):

acil(CCGC):

780 1586

278 714 1150

aflili (ACRYGT): ahalil (TTTAAA):

ahdI (GACNNNNNGTC):

aluI (AGCT):

alw261 (CAGNNNCTG):

alwni (CAGNNNCTG): alwi (GGATCNNN):

apol (RAATTY): apyI (CCWGG):

asp700 (GAANNNTTC):

aspHI (GWGCWC):

1464 1749

101 316